UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,266	05/10/2001	Shunpei Yamazaki	12732-035001 / US4908	5445

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EXAMINER
EHICHIOYA, FRED I

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		09/852,266	YAMAZAKI ET AL.
		Examiner	Art Unit	
		Fred I. Ehichioya	2162	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 June 2005</u>.

2a)☐ This action is **FINAL.** 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1 - 63</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1 - 63</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>6/3/05</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

1. This action is responsive to communications: RCE filed June 3, 2005 to the original

   application filed 05/10/01.

2. Claims 1 – 63 are pending.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth

   in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

   application is eligible for continued examination under 37 CFR 1.114, and the fee set

   forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

   has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

   6/3/05 has been entered.

Response to Arguments/Remarks

4. Applicants' argue:

   (a) Uchida UK does not describe or suggest sending means for sending a notice of

   coincidence as data to mating parting or a manager when collation result proves

   coincident (page 1, paragraph 3).

   (b) "In particular, the passage merely notes that a password is conventionally used

   to certify the authenticity of a user, and in no way says anything about rewriting

   reference body information" (page 2, paragraph 4).

In response to argument (a), Examiner respectfully disagrees with the applicants.
USPN 6,751,733 issued to Nakamura et al teaches a sending means for sending a
notice of coincidence to a mating part or a manager when collation result proves
coincident as shown in column 7, lines 53 – 64. It should be noted that as described by
the applicants in the specification pages 4 – 5, collation is authentication operations
used living body (fingerprint o0e voiceprint). Since Nakamura discloses sending
authentication result to the controller or web server, it inherent that Nakamura discloses
a sending means for sending a notice of coincidence as data to a mating party when a
collation result proves coincident as described in column 7, lines 53 – 64).

In response to argument (b), Examiner wishes to thank the applicants for
agreeing that Uchida teaches the use of a password to certify the authenticity of a user.
However, Nakamura teaches Wherein a password is sent as a data to the manager
after the notice of collation is sent to the manager (see column 7, lines 53 – 64), and the
reference living body information is written when the password is authenticated as
correct on the manager as shown in column 15, lines 6 – 8.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

6. Claims 1 – 20, 23, 25 – 36, 43 – 45, 49 – 58, 60, 61 and 63 are rejected under 35

U.S.C. 103(a) as being unpatentable over Uchida in view of USPN 6,751,733 issued

to Nakamura et al (hereinafter "Nakamura").

Regarding claims 1, 7, 55 and 56 Uchida teaches a communication system for

distinguishing a user, said system comprising:

a storing means for storing reference living body information (see page 20, lines

13 – 17; Uchida discloses "fingerprint" as "living body");

a reading means for reading collation living body information of the user (see

page 21, lines 17 – 19);

a collating means for collating the collation living body information with the

reference living body information (see page 22, lines 1 – 9; Uchida discloses "checking

unit 12" as "collating means").

wherein a communication between the user and a mating party is started through

the manager after the mating party receives the notice of coincidence as data (see page

23, lines 5 – 10); Uchida discloses "authenticating executing device 2" as "mating

party").

Uchida does not explicitly teach sending a notice of coincidence as claimed.

Nakamura teaches a sending means for sending a notice of coincidence as data

to a mating party when a collation result proves coincident (see column 7, lines 53 - 64),

It would have been obvious to one of ordinary skill in the data processing art at

the time of the present invention to combine teaching of the cited references because

Nakamura's teaching of "a sending means for sending a notice of coincidence as data

to a mating party when a collation result proves coincident" would have allowed

Uchida's system to encrypts biometrics information that is user's personal information,

and transfers the biometrics information over a network in such a state that only an

authentication server, which the user assigns, can decode the biometrics information.

Therefore, it is possible to securely protect user's privacy that is the biometrics

information in a style of reflecting user's intention, and to prevent reuse of invalid

authentication information since it is possible to confirm the date and time, when the

authentication information was generated, by the authentication server.

Furthermore, it is possible to keep the security of a system firm since an

authenticated side can confirm whether the user is authenticated as suggested by

Nakamura (see Abstract).

Regarding claims 11 and 17, Uchida teaches a communication system for

distinguishing a user, said system comprising:

a storing means for storing reference living body information (see page 20, lines

13 – 17; Uchida discloses "fingerprint" as "living body");

a reading means for reading collation living body information of the user (see

page 21, lines 17 – 19);

a collating means for collating the collation living body information with the

reference living body information (see page 22, lines 1 – 9; Uchida discloses "checking

unit 12" as "collating means").

Uchida does not explicitly teach sending a notice of coincidence and living body

information is rewritten when the password is authenticated as claimed.

Nakamura teaches a sending means for sending a notice of coincidence as data

to a mating party when a collation result proves coincident (see column 7, lines 53 - 64),

wherein a password is sent as data to the mating party/manager after the notice

of collation is sent to the mating party/manager (see column 14, lines 44 – 51), and the

reference living body information is rewritten when the password is authenticated as

correct on the mating party (see column 15, lines 6 – 8).

It would have been obvious to one of ordinary skill in the data processing art at

the time of the present invention to combine teaching of the cited references because

Nakamura's teaching of "a sending means for sending a notice of coincidence as data

to a mating party when a collation result proves coincident" would have allowed

Uchida's system to encrypts biometrics information that is user's personal information,

and transfers the biometrics information over a network in such a state that only an

authentication server, which the user assigns, can decode the biometrics information.

Therefore, it is possible to securely protect user's privacy that is the biometrics

information in a style of reflecting user's intention, and to prevent reuse of invalid

authentication information since it is possible to confirm the date and time, when the

authentication information was generated, by the authentication server.

Furthermore, it is possible to keep the security of a system firm since an

authenticated side can confirm whether the user is authenticated as suggested by

Nakamura (see Abstract).

Regarding claims 2 and 12, Uchida teaches a wherein the reference living body

information comprises n reference living body information, the collation living body

information of the user comprises n collation living body information of the user, the

collating means collates the n collation living body information with the n reference living

body information, and the sending means sends the notice of coincidence as data to the

mating party when all of collation results prove coincident (see page 8, lines 15 – 24).

Regarding claims 3 and 13, Uchida teaches wherein the reference living body

information comprises n reference living body information, the collation living body

information of the user comprises in collation living body information of the user, the

collating means collates the m collation living body information with the n reference

living body information, and the sending means sends the notice of coincidence as data

to the mating party when at least one of the n reference living body information

coincides with at least one of the m collation living body information (see page 21, lines

14 – 27).

Regarding claims 4 and 14, Uchida teaches wherein the reference living body

information comprises a plurality of kinds of reference living body information, the

collation living body information of the user comprises a plurality of kinds of collation

living body information of the user, the collating means collates the plurality of collation

living body information with the plurality of reference living body information, and the

sending means sends the notice of coincidence as data to the mating party when the

plurality of kinds of collation living body information wholly coincide with the plurality of

kinds of reference living body information (see page 29, lines 4 – 23, page 30, lines 19 –

27 and page 31, lines 1 – 29).

Regarding claims 5 and 15, Uchida teaches wherein the reference living body information comprises n reference living body information of a plurality of kinds, the collation living body information comprises in collation living body information of a plurality of kinds of a user, the collating means collates the m collation living body information with the n reference living body information, and the sending means sends the notice of coincidence as data to the mating party when at least one of each kind of collation living body information among the plurality of kinds of collation living body information coincides with at least one of each kind of reference living body information among the n reference living body information (see page 23, lines 5 – 23).

Regarding claims 6 and 16, Uchida teaches wherein the reference living body information comprises n reference living body information of a plurality of kinds, the collation living body information comprises m collation living body information of a plurality of kinds of a user, the collating means collates the in collation living body information with the n reference living body information, and the sending means sends the notice of coincidence as data to the mating party when all of the plurality of kinds of collation living body information coincide with all of the n reference living body information (see page 21, lines 14 – 27).

Regarding claims 8 and 9, Uchida teaches a causing means for causing the manager to send the notice of coincidence as data to a mating party (see page 24, lines 7 – 21 and page 29, lines 13 – 23),

wherein the communication between the user and the mating party is directly

started after the mating party receives the notice of coincidence as data (see page 27,

lines 21 - 27).

Regarding claims 10 and 27, Uchida teaches wherein a transaction is conducted

between the user and the mating party (see page 1, lines 7 – 14),

wherein an identification of the user is requested only when the condition set to

the mating party is satisfied (see page 28, lines 10 – 15).

Regarding claims 18, 28, 29 and 30, Uchida teaches wherein the reference living

body information comprises at least one selected from the group consisting of a

fingerprint, a palm print and a voiceprint (see page 35, lines 7 – 16).

Regarding claims 19, 31, 32 and 33, Uchida teaches wherein the collation living

body information comprises at least one selected from the group consisting of a

fingerprint, a palm print and a voiceprint (see page 35, lines 7 – 16).

Regarding claims 20, 26, 34, 35, 36, 52, 53 and 54, Uchida teaches wherein the

palm print is a palm print of the whole palm or a palm print of a part of the palm (see

page 35, lines 7 – 16).

Regarding claims 23, 43, 44, 45, 58 and 61 Uchida teaches a portable information terminal is used (see page 35, lines 17 – 22).

Regarding claims 25, 49, 50, 51, 60 and 63, Uchida teaches a personal computer is used (see page 1, lines 16 – 22).

Regarding claim 57, Uchida teaches the transmitting means send the signal of performing authentication of the user to at least the mating party and the manager (see column 5, lines 31 – 44).

7. Claims 21, 22, 24, 37 – 42, 46 – 48, 69 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida in view of Nakamura and further in view of USPN 6,219,793 issued to Yang Li et al (hereinafter "Li").

Regarding claims 21, 37, 38 and 39, Uchida and Nakamura disclose the claimed subject matter as discussed in 1, 7, 11 and 17 respectively. Uchida or Nakamura does not explicitly teach a flash memory.

Li teaches the storing means is a flash memory (column 12, lines 20 – 27).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Li's teaching of "storing means is a flash memory" would have allowed Uchida and Nakamura's system to involve the use of fingerprint matching to authenticate a call or

other communication over a wireless communication network as suggested by Li at

column 3, lines 10 - 12.

Regarding claims 22, 40, 41 and 42, Li teaches the reading means is a

photodiode or a charge coupled device (see column 4, lines 50 – 65).

Regarding claims 24, 46, 47, 48, 59 and 62 Li teaches a cellular telephone is

used (see column 4, lines 33 – 49).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 571-272-4034. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fred I. Ehichioya
Patent Examiner
Art Unit 2162

June 10, 2005

SHAHID ALAM
PRIMARY EXAMINER